

## REMARKS

### **I. Introduction**

In the Office Action mailed September 29, 2006, Claims 1-13, 15, 17, 18, 20-23, 33, 35, 37, 38, and 40-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,007,034, to Hartman et al. (hereinafter "Hartman") in view of U.S. Patent No. 6,968,332, to Milic-Frayling et al. (hereinafter "Milic-Frayling"). Claims 16 and 36 were rejected as being unpatentable over Hartman and Milic-Frayling, and further in view of U.S. Patent No. 6,925,444, to McCollom et al. (hereinafter "McCollom"). Claims 19 and 39 were rejected as being unpatentable over Hartman and Milic-Frayling, and further in view of U.S. Patent Pub. No. 2001/0007980, to Ishibashi et al. (hereinafter "Ishibashi"). Lastly, Claims 24-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,694,331, to Lee et al. (hereinafter "Lee").

Claims 1-13, 15-33, and 35-47 remain pending in this application. Independent Claims 1, 24, and 33 have been amended. Applicants have carefully reviewed the cited art and submit that the amended claims are in patentable condition. Applicants thus request reconsideration and allowance of this application.

### **II. Interview Summary**

Prior to discussing the patentability of the claims over the cited art, the undersigned counsel wishes to thank Examiner Le for the time and consideration she extended in a telephone interview conducted December 19, 2006. In summary, the undersigned counsel and Examiner Le discussed the present application and the aspects thereof that distinguish the claimed invention over the cited art. Claims 1, 24, and 33 have been amended to clarify these distinguishing aspects.

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### **III. Claims 1-13, 15, 17, 18, and 20-23 Are Patentable Over Hartman and Milic-Frayling**

Claims 1-13, 15, 17, 18, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Hartman and Milic-Frayling. The disclosures of Hartman and Milic-Frayling, however, fail to teach each and every element of these claims, and thus do not provide a *prima facie* basis for rejecting the claims.

#### **A. Independent Claim 1**

For convenience of examination, amended Claim 1 is repeated as follows:

1. A method for electronically searching a user-personalized library of content, comprising:

(a) receiving one or more search terms from a user having an electronically-searchable personalized library of content, the personalized library including a text searchable database and a page image database;

(b) electronically searching the text searchable database for pages of content that match the search terms to produce search results;

(c) providing the search results to the user;

(d) receiving a search result selection from the user; and

(e) providing to the user an image of a page of content in the page image database based on the user's search result selection, wherein prior to providing the image of the page of content to the user, the appearance of the image is modified in accordance with one or more access rules to limit an amount of content in the image, such that only a portion of the image of the page of content is viewable by the user when the image is displayed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). *See also* M.P.E.P. § 2143.

Neither Hartman nor Milic-Frayling teaches or suggests providing to the user an image of a page of content "wherein prior to providing the image of the page of content to the user, the appearance of the image is modified in accordance with one or more access rules to limit an

amount of content in the image, such that only a portion of the image of the page of content is viewable by the user when the image is displayed," as claimed in Claim 1.

The Office Action cited Hartman at Col. 3, lines 48-55 for its teaching of "prerequisite checking", but this aspect of Hartman does not teach or suggest "access rules" that "limit an amount of content in [an] image". To the contrary, the prerequisite checking taught by Hartman causes *additional* content to be provided to a user. See, e.g., Col. 3, lines 53-55 of Hartman in which "selection by the user of an entity prerequisites causes automatic inclusion of all associated prerequisite objects in the final compilation."

Recognizing the deficiencies of Hartman, the Office Action further referred to Milic-Frayling at Col. 2, line 53 to Col. 3, line 59 as allegedly disclosing "using one or more access rules to limit an amount of content in the image of the page of content being provided to the user." However, this reliance on Milic-Frayling is misplaced. Milic-Frayling, at best, merely *extracts* specified features *from* a document (see Col. 2, line 60) or otherwise attempts to summarize the document. However, the extracted information is displayed separate from the document. See Col. 17, lines 26-31 of Milic-Frayling.

An alternative feature taught by Milic-Frayling is "constructing thumbnail images of documents with query terms highlighted" (see Col. 2, lines 63-64), but Milic-Frayling nowhere suggests that the thumbnail images are acted upon in any fashion to "limit an amount of content in the image," as claimed in present Claim 1. Rather, the content in the thumbnail images is merely supplemented with additional highlight.

In contrast to the prior art, amended Claim 1 recites "providing to the user an image of a page of content in the page image database based on the user's search result selection, wherein prior to providing the image of the page of content to the user, the appearance of the image is modified in accordance with one or more access rules to limit an amount of content in the image, such that only a portion of the image of the page of content is viewable by the user when the

image is displayed." Examples of an image having a modified appearance are provided in the present application at FIGURE 6 (where, compared to the image in FIGURE 4, only the text in the image is viewable and the picture has been suppressed) and at FIGURE 11 (where an image of "Page 17" is shown with only certain text being viewable). Further reference may be made, for example, to the description in the present application at page 18, line 24 to page 19, line 14.

For the above reasons, applicants submit that Claim 1 is patentable over Hartman and Milic-Frayling.

As an additional reason for patentability, applicants further note that Hartman and Milic-Frayling fail to teach the elements of "(a) receiving one or more search terms from a user having an electronically-searchable personalized library of content, the personalized library including a text searchable database and a page image database" and "(b) electronically searching the text searchable database for pages of content that match the search terms to produce search results." In Hartman, it is a central library server 44 that is searched. Nowhere does Hartman suggest a "user having an electronically-searchable personalized library of content" that includes a "text searchable database" and a "page image database." The "client cache" disclosed by Hartman includes copies of objects for faster retrieval, but this cache is not searched based on terms received from a user. Applicants have studied the disclosure of Milic-Frayling and do not find any teaching that overcomes the deficiency of disclosure in Hartman. Accordingly, for this additional reason, the rejection of Claim 1 should be withdrawn.

In view of the above, applicants respectfully submit that the cited and applied references do not provide a *prima facie* basis to reject Claim 1. Claim 1 should be allowed.

B. Dependent Claims 2-13, 15, 17, 18, and 20-23

Claims 2-13, 15, 17, 18, and 20-23 are dependent on Claim 1 and thus are allowable for the reasons discussed above in connection with Claim 1. Claims 2-13, 15, 17, 18, and 20-23 also include subject matter not disclosed, taught or suggested by the cited and applied references,

particularly when the subject matter is considered in combination with the claims from which these claims depend. For example, Claim 23 recites "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Hartman and Milic-Frayling fails to teach, disclose, or suggest. The Office relied on Hartman for teaching such an element, citing Col. 6, line 44 to Col. 7, line 60, and Col. 7, line 61 to Col. 8, line 59. (Office Action, Page 13). However, applicants respectfully disagree. Applicants do not see any mention of text data related to a non-text object in the cited passages.

The rejection of Claims 2-13, 15, 17, 18, and 20-23 should be withdrawn.

**IV. Claims 24-32 Are Patentable Over Lee, As Well As Hartman and Milic-Frayling**

The Office Action cited Lee as anticipating Claims 24-32. Applicants request reconsideration and allowance of Claims 24-32 for the following reasons.

**A. Independent Claim 24**

For convenience of examination, amended Claim 24 recites as follows:

24. A method for preparing a user-personalized library of content for electronic searching and delivery of content to a user, comprising:

(a) acquiring a general library of content that includes images and corresponding text of pages of content;

(b) preparing a page image database comprised of the images of pages of content;

(c) preparing a text searchable database comprised of the corresponding text of pages of content;

(d) receiving from a user a selection of content in the general library to form a user-personalized library of content that the user can electronically search using the text searchable database;

(e) identifying an image of a page of content in the page image database based on a search of the text searchable database; and

content in the image, wherein only a portion of the image of the page of content is viewable by the user when the image is displayed.

While applicants disagree with the application of *Lec*, Claim 24 has been amended to further distinguish the claimed subject matter. As amended, Claim 24 now recites, in part, "modifying the appearance of the image of the page of content in accordance with one or more access rules to limit an amount of content in the image, wherein only a portion of the image of the page of content is viewable by the user when the image is displayed," with is neither taught nor suggested by *Lec*. Absent a teaching of all the elements of Claim 24, *Lee* cannot be asserted as anticipating Claim 24. The rejection of Claim 24 should be withdrawn.

Applicants have further considered the disclosures of Hartman and Milic-Frayling and find them to be deficient in this respect as well. The discussion of Hartman and Milic-Frayling provided above relative to Claim 1 is applicable to amended Claim 24.

Claim 24 should be allowed.

B. Dependent Claims 25-32

Claims 25-32 are dependent on Claim 24 and thus are allowable for the reasons discussed above in connection with Claim 24. Claims 25-32 also include subject matter not disclosed, taught or suggested by any of the cited and applied references, particularly when they are considered in combination with the claims from which they depend. Accordingly, for this reason, applicants request allowance of Claims 25-32.

V. Claims 33, 35, 37, 38, and 40-47 Are Patentable Over Hartman and Milic-Frayling

Claims 33, 35, 37, 38, and 40-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Hartman and Milic-Frayling. The disclosures of Hartman and Milic-Frayling, however, fail to teach each and every element of these claims.

A. Independent Claim 33

In amended form, Claim 33 recites:

33. A computer system that provides electronic searching of a user-personalized library of content, comprising a search server in communication with a database server, in which the database server is configured with a general library of content that is accessible to multiple users, the general library including (1) a page image database containing images of pages of content, (2) an access rights database containing access rules that define the scope of content to be displayed to each user, and (3) a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text, the search server being configured with a search engine comprised of computer-implemented instructions that enable the search server to:

- (a) receive one or more search terms from a user having established a personalized library within the general library of content,
- (b) search the full text of the user's personalized library for pages of content that match the search terms,
- (c) provide the results of the full text search to the user for selection by the user, and
- (d) provide to the user a page image from the page image database based on the user's search result selection, the content in the page image being provided within the scope defined by the access rules, wherein the scope defined by the access rules defines an amount of content in the page image that is viewable by the user when the page image is displayed.

Claim 33 recites a computer system that provides electronic searching of a user-personalized library of content. As claimed in Claim 33, the computer system specifically includes "an access rights database containing access rules that define the scope of content to be displayed to each user" as well as computer-implemented instructions that enable the search server to "provide to the user a page image from the page image database based on the user's search result selection, the content in the page image being provided within the scope defined by the access rules, wherein the scope defined by the access rules defines an amount of content in the page image that is viewable by the user when the page image is displayed."

For reasons similar to those discussed above with respect to Claim 1, both Hartman and Milic-Frayling fail to teach an access rights database as claimed, and further fail to teach

providing content in a page image "within the scope defined by the access rules, wherein the scope...defines an amount of content in the page image that is viewable by the user when the page image is displayed." Accordingly, applicants respectfully submit that the rejection of Claim 33 is in error and request that the rejection be withdrawn.

B. Dependent Claims 35, 37, 38, and 40-47

Claims 35, 37, 38, and 40-47 are dependent on Claim 33 and thus are allowable for the reasons discussed above in connection with Claim 33. Claims 35, 37, 38, and 40-47 also include subject matter not disclosed, taught or suggested by any of the cited and applied references, particularly when the subject matter is considered in combination with the subject matter of the claims from which these claims depend. For example, Claim 43 recites "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Hartman and Milic-Frayling fail to teach, notwithstanding the citation of Hartman at Col. 6, line 44 to Col. 7, line 60, and Col. 7, line 61 to Col. 8, line 59. The discussion provided above relative to Claim 23 is applicable to Claim 43.

Applicants respectfully submit that Claims 35, 37, 38, and 40-47 are patentable.

VI. Claims 16 and 36 Are Patentable Over Hartman, Milic-Frayling and McCollom

In the Office Action, Claims 16 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harman and Milic-Frayling in combination with McCollom.

As a preliminary matter, applicants note that Claim 16 depends from Claim 1, while Claim 36 depends from Claim 33. Applicants respectfully submit that these claims are allowable for the reasons described above in regard to Claims 1 and 33. Moreover, Claims 16 and 36 include subject matter not disclosed, taught, or suggested by any of the cited and applied references. Claims 16 and 36 each recite "the access rules define a percentage of content that can be provided to the user over a time frame." The Office relied on Col. 9, lines 9-34 of McCollom as allegedly teaching access rules as claimed, but this reliance is misplaced. The cited passage



merely discusses various reports that can be provided. As McCollom fails to teach the above element recited in Claims 16 and 36, a case of *prima facie* obviousness has not been established.

Claims 16 and 36 should be allowed.

**VII. Claims 19 and 39 Are Patentable Over Hartman, Milic-Frayling and Ishibashi**

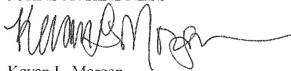
Claims 19 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harman and Milic-Frayling in combination with Ishibashi. Applicants note that Claim 19 depends from Claim 1, while Claim 39 depends from Claim 33. These claims are allowable for the reasons described above in regard to Claims 1 and 33. Moreover, Claims 19 and 39 include subject matter not disclosed, taught, or suggested by any of the cited and applied references. Applicants disagree that Ishibashi teaches the element of reviewing purchase records to validate ownership of content, particularly in a manner that can be combined with Hartman and Milic-Frayling. Claims 19 and 39 should thus be allowed.

**VIII. Conclusion**

In view of the foregoing amendments and remarks, applicants submit that all pending claims are in patentable condition and respectfully request an early notice to that effect. The Examiner is requested to contact applicants' attorney at the number provided below should any questions or issues remain.

Respectfully submitted,

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